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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,458	11/17/1999	BRIAN T. MURPHY	06502.0260	4347

22852 7590 03/26/2003

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EXAMINER

EL HADY, NABIL M

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/441,458

Applicant(s)

MURPHY ET AL.

Examiner

Nabil M El-Hady

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-6, 8, 10-12, 14, 15, 17
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Claimed 1-27 are pending in this application.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,185,611.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and U.S. Patent No. 6,185,611 disclose a distributed system having a lookup discovery service and lookup services with associated network services with client accessing the network services.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1-13, and 16-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Waldo et al. (USPN 6,185,611), hereafter "Waldo".

6. As to claims 1 and 19, Waldo discloses the invention including a method and computer-readable medium containing instructions for controlling a data processing system comprising receiving a request by a lookup discovery service to return locator information that facilitates access to a lookup service, and transmitting the request to the lookup service (col. 5, lines 60-67; and col. 3, lines 29-36).

7. As to claims 6 and 24, the claims are rejected for the same reasons as claims 1 and 19 above. In addition, Waldo discloses that the request received by the lookup discovery service is transmitted by a client (Fig. 3A), and that the request is transmitted to at least one of a plurality of lookup services (inherent in col. 5, lines 47-50).

8. As to claim 13, the claim is rejected for the same reasons as claims 1 and 6 above. In addition, Waldo discloses, in a data processing system, a client computer, a lookup discovery service for accessing associated lookup services (Fig. 1 and Fig. 2), and a lookup service containing service stubs for accessing associated services (col. 7, lines 53-57). Waldo also discloses returning the locator information of the lookup service that satisfied the client's request (inherent in col. 10, lines 63-67).

9. As to claims 2, 8, 20, and 26, Waldo discloses receiving a request to register with the look up discovery service (col. 5, lines 60-63, 66-67).

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10. As to claims 3, 9, 11, 21, and 27, Waldo discloses transmitting a multicast packet comprising a request to access the lookup service (col. 10, lines 47-63).

11. As to claims 4, 12, and 22, Waldo discloses transmitting a unicast packet comprising a request to access a lookup service (col. 10, lines 64-67).

12. As to claims 5, 7, 10, 23, and 25, Waldo discloses receiving lookup service locator information by the lookup discovery service, and transmitting the locator information to a client (col. 5, lines 63-66; col. 10, 47-59; and col. 13, lines 14-16).

13. As to claim 16, Waldo discloses returning the null value if no lookup service satisfying the client's request is found (col. 9, lines 23-25).

14. As to claims 17 and 18, the claims are rejected for the same reasons as claims 1, 6, and 13 above. In addition, Waldo discloses a distributed system with a plurality of services (col. 4, lines 64-67, col. 5, lines 1-12) comprising a first server computer with a memory containing a lookup discovery service (102, Fig. 1, 214, Fig. 2), a second server computer with a memory containing a lookup service having stub (102, Fig. 1, 212, Fig. 2)), and a processor (206, Fig. 2) for running the lookup service, and a client computer (col. 5, lines 8-19).

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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16. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waldo et al. (USPN 6,185,611), hereafter "Waldo".

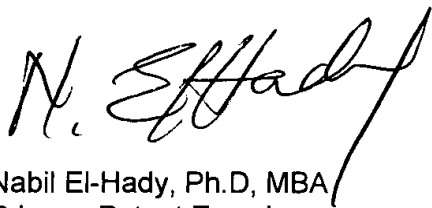
17. As to claims 14 and 15, Waldo does not necessarily disclose transmitting a request for a plurality of lookup services or returning lookup service locator information for a plurality of lookup services. However, it would have been obvious to one skilled in the art at the time of the invention to exploit the characteristics of the Java programming environment where services appearing as objects, and the flexibility of the distributed system, to be able to transmit a request for a plurality of lookup services and receive service locator information for the plurality of lookup services.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M El-Hady whose telephone number is (703) 308-7990. The examiner can normally be reached on 9:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai T An can be reached on (703) 305-9678. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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A handwritten signature in black ink, appearing to read "N. El-Hady". The signature is fluid and cursive, with a long, sweeping tail that extends downwards and to the right.

Nabil El-Hady, Ph.D, MBA
Primary Patent Examiner
March 23, 2003